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In re Patent No. 4,818,816 :
Issue Date: April 4, 1989 :
Application No. 07/115,593 : **ON PETITION**
Filed: October 26, 1987 :
Patentees: Maurice Petitou et al. :

This is a decision on the petition under 37 CFR 1.182, filed March 11, 1996, requesting that the terminal disclaimer under 35 U.S.C. § 253 filed on October 23, 1988 be withdrawn in favor of a newly submitted terminal disclaimer.

The petition is **DENIED**.

BACKGROUND

A Notice of Allowance and Notice of Allowability were mailed on June 13, 1988 in the above-identified application.

A terminal disclaimer under 35 U.S.C. § 253 and 37 CFR 1.321 was voluntarily filed on October 23, 1988. The terminal disclaimer of October 23, 1988 was executed by Pierre Williams on behalf on Choay, S.A., and stated that:

Your petitioner, Choay, S.A., hereby disclaims the terminal part of any patent on the above-identified application which would extend beyond the expiration date of U.S. Patent No. 4,607,025, issued on August 19, 1986, . . .

The above-identified application issued as U.S. Patent No. 4,818,816 on April 4, 1989.

The instant petition under 37 CFR 1.182 was filed on March 11, 1996, and requests that the terminal disclaimer filed on

October 23, 1988 be withdrawn in favor of a newly submitted terminal disclaimer stating that:

Choay, S.A., hereby disclaims, except as provided below, the terminal part of the statutory term of the above-identified patent which extends beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 to 156 of U.S. Patent No. 4,607,025, issued on August 19, 1986, . . .

STATUTE AND REGULATION

35 U.S.C. § 253 states that:

Whenever, without any deceptive intention, a claim of a patent is invalid the remaining claims shall not thereby be rendered invalid. A patentee, whether of the whole or any sectional interest therein, may, on payment of the fee required by law, make disclaimer of any complete claim, stating therein the extent of his interest in such patent. Such disclaimer shall be in writing and recorded in the Patent and Trademark Office, and it shall thereafter be considered as part of the original patent to the extent of the interest possessed by the disclaimant and by those claiming under him.

In like manner any patentee or applicant may disclaim or dedicate to the public the entire term, or any terminal part of the term, of the patent granted or to be granted.

35 U.S.C. § 255 provides that:

Whenever a mistake of a clerical or typographical nature, or of minor character, which was not the fault of the Patent and Trademark Office, appears in a patent and a showing has been made that such mistake occurred in good faith, the Commissioner may, upon payment of the required fee, issue a certificate of correction, if the correction does not involve such changes in the patent as would constitute new matter or would require reexamination. Such patent, together with the certificate, shall have the same effect and operation in law on the trial of actions for causes thereafter arising as if the same had been originally issued in such corrected form.

37 CFR 1.323 provides that:

Whenever a mistake of a clerical or typographical nature or of minor character which was not the fault of the Office, appears in a patent and a showing is made that such mistake occurred in good faith, the Commissioner may, upon payment of the fee set forth in § 1.20(a), issue a certificate, if the correction does not involve such changes in the patent as would constitute new matter or would require reexamination. A request for a certificate of correction of a patent involved in an interference shall comply with the requirements of this section and shall be accompanied by a motion under § 1.635.

37 CFR 1.325 provides that:

Mistakes other than those provided for in §§ 1.322, 1.323, 1.324, and not affording legal grounds for reissue or for reexamination, will not be corrected after the date of the patent.

OPINION

Petitioner (Choay, S.A.) asserts that U.S. Patent No. 4,607,025 recently expired due to failure to pay a maintenance fee. Petitioner argues that the language of the terminal disclaimer filed on October 23, 1988 might be ambiguous as to whether the "expiration date of U.S. Patent No. 4,607,025" set forth therein is measured from the full statutory term of U.S. Patent No. 4,607,025, or the actual term U.S. Patent No. 4,607,025 due to the failure to timely submit a maintenance fee. Petitioner requests that the terminal disclaimer submitted with the instant petition be substituted for the terminal disclaimer filed on October 23, 1988 to resolve this potential ambiguity.

The statutory authority for amendment or correction of an issued patent is found in title 35, chapter 25. The instant petition does not involve correction of a mistake by the Patent and Trademark Office (Office) (35 U.S.C. § 254) or correction of the named inventor (35 U.S.C. § 256). In addition, while the instant petition involves a disclaimer, 35 U.S.C. § 253 merely authorizes the filing and recording of disclaimers; it does not authorize the withdrawal of a terminal disclaimer. Finally, petitioners have not sought amendment or correction by reissue (35 U.S.C. §§ 251 and 252).

Unless a "mistake" is provided for in 37 CFR 1.322, 1.323, or 1.324, or affords legal grounds for reissue or for reexamination,

such "mistake" will not be corrected subsequent to the issuance of an application as a patent. See 37 CFR 1.325. As stated in section 1490 of the Manual of Patent Examining Procedure (MPEP) (6th Ed., Rev. 1 1995), the mechanisms to correct a patent (i.e., certificate of correction (35 U.S.C. § 255), reissue (35 U.S.C. § 251), and reexamination (35 U.S.C. § 305)) are not available to withdraw or otherwise nullify the effect of a recorded terminal disclaimer. The Supreme Court has stated that, as a general principle, public policy does not favor the restoration to a patent of that which has been dedicated to the public by disclaimer. See Altoona Publix Theatres, 294 U.S. 477, 492, 24 USPQ 308, 315 (1935); see also Leggett v. Avery, 101 U.S. (11 Otto) 256, 259-60 (1879).

In any event, to withdraw the terminal disclaimer filed on October 23, 1988 and properly recorded in the above-identified patent, such action must be authorized pursuant to 35 U.S.C. § 255.

A Certificate of Correction under 35 U.S.C. § 255 and 37 CFR 1.323 is available for the correction of errors of a minor or clerical character, and does not extend to the correction of errors that would constitute new matter or would require reexamination. See In re Arnott, 19 USPQ2d 1049, 1054 (Comm'r Pats. 1991); In re Hyman, 185 USPQ 441, 442 (Sol. Pat 1975). Specifically, 35 U.S.C. § 255 requires, *inter alia*, that two specific and separate requirements be met prior to the issuance of a Certificate of Correction. The first requirement is that the mistake is: (1) of a clerical nature, (2) of a typographical nature, or (3) of minor character. The second requirement is that the correction must not involve changes that would: (1) constitute new matter or (2) would require reexamination. See Arnott 19 USPQ2d at 1052; see also MPEP 1490.

The "mistake" at issue involves the failure to specify in the terminal disclaimer filed on October 23, 1988 that petitioner does not disclaim the terminal part of the above-identified patent which extends beyond the expiration date U.S. Patent No. 4,607,025, unless such expiration date is based upon the full statutory term defined in 35 U.S.C. §§ 154 to 156 of U.S. Patent No. 4,607,025. This "mistake," however, is not one of a clerical or typographical nature; rather, it involves a substantive re-drafting of the language in the terminal disclaimer to be recorded for the above-identified patent. In addition, as this "mistake" involves altering the language concerning the expiration date of the above-identified patent (i.e., correction of this "mistake" would potentially result in changing the term of the above-identified patent), this "mistake" cannot reasonably be characterized as one of minor character. See MPEP 1490.

Since the first requirement under 35 U.S.C. § 255 is not met (i.e., the "mistake" sought to be corrected is not of the type proper for correction under 35 U.S.C. § 255), whether the withdrawal of the terminal disclaimer filed on October 23, 1988 in favor of a newly submitted terminal disclaimer would constitute new matter or require reexamination is moot. Id.

Accordingly, the Certificate of Correction is not available for the requested correction.

Assuming, *arguendo*, that the patent statutes authorized the withdrawal of the terminal disclaimer filed on October 23, 1988 in favor of a newly submitted terminal disclaimer, such action would not constitute an appropriate exercise of the Commissioner's discretion under 37 CFR 1.182 or 1.183 or 35 U.S.C. § 255 and 37 CFR 1.323. Granting the requested relief would operate to evade the requirements of the reissue statutes (i.e., 35 U.S.C. §§ 251 and 252). The remedial nature of reissue notwithstanding, reissue is not available to correct all errors. Specifically, it is the Office's position that reissue is not available to withdraw or otherwise nullify the effect of a terminal disclaimer recorded in an issued patent. See Ex parte Anthony, 230 USPQ 467 (Bd. App. 1982), affd, Appeal No. 84-1357 (Fed. Cir. 1985); see also MPEP 1490.


Thus, the "mistake" at issue is not provided for in 37 CFR 1.322, 1.323, or 1.324, and does not afford legal grounds for reissue or for reexamination. Therefore, the PTO will not, pursuant to 37 CFR 1.182 or 1.183, withdraw or otherwise nullify the effect of a disclaimer properly recorded in an issued patent. See 37 CFR 1.325; MPEP 1490. The PTO, however, expresses no opinion on the effect on the above-identified patent of the expiration of U.S. Patent No. 4,607,025 for failure to timely pay a maintenance fee.

CONCLUSION

For the above stated reasons, the request to withdraw the terminal disclaimer under 35 U.S.C. § 253 and 37 CFR 1.321 filed on October 23, 1988 in favor of a newly submitted terminal disclaimer is **denied**.

Telephone inquiries should be directed to the Office of Petitions Staff at (703) 305-9282.

The patent file is being returned to Files Repository.



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